



DAC

Docket No. 4290-4000

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**RECEIVED**

**JUN 22 2004**

**OFFICE OF PETITIONS**

Applicant(s): IHLE, Oystein et.al.

Group Art Unit: 1645

Serial No.: 09/870,128

Examiner:

Filed: May 30, 2001

For: Method for Separating Nucleic Acids into Populations

**Supplemental Submission in Support of Petition to Revive Unintentionally Abandoned  
Patent Application**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

On March 2, 2004 we filed a Petition to Revive an Unintentionally Abandoned Patent Application along with a supporting statement, fee of \$665.00 and documents associated with the response to File Missing Parts. At the time the Petition was filed the application was abandoned, as a matter of law, for failure to respond to a "Notice to File Missing Parts" mailed on August 3, 2001. As of the filing of the Petition to Revive Unintentionally Abandoned Patent Application, Morgan & Finnegan had not yet received a Notice of Abandonment in this case. Morgan & Finnegan has now received the Notice of Abandonment mailed June 2, 2004 and we note that a

copy of this Notice must accompany the Petition to Revive. Therefore, as required, a copy of the Notice of Abandonment dated June 2, 2004 is enclosed, along with a courtesy copy of the petition papers originally filed on March 2, 2004. Timely consideration of our Petition is requested.

Respectfully submitted,  
MORGAN & FINNEGAN, L.L.P.

Dated: June 17, 2004

By: 

Brian Brown

Registration No. 47,265

(202) 857-7887 Telephone

(202) 857-7929 Facsimile

Correspondence Address:

MORGAN & FINNEGAN, L.L.P.

345 Park Avenue

New York, NY 10154-0053



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
 United States Patent and Trademark Office  
 Address: COMMISSIONER FOR PATENTS  
 P.O. Box 1450  
 Alexandria, Virginia 22313-1450  
 www.uspto.gov

APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
09/870,128	05/30/2001	Oystein Ihle	4290-4000

DOROTHY R. AUTH  
 MORGAN & FINNEGAN, L.L.P.  
 345 PARK AVENUE  
 NEW YORK, NY 10154

RECEIVED

JUN 22 2004

OFFICE OF PETITIONS

CONFIRMATION NO. 6505

ABANDONMENT/TERMINATION  
LETTER

\*OC000000012844730\*

Date Mailed: 06/02/2004

## NOTICE OF ABANDONMENT UNDER 37 CFR 1.53 (f) OR (g)

The above-identified application is abandoned for failure to timely or properly reply to the Notice to File Missing Parts (Notice) mailed on 08/03/2001.

- The reply received on 05/30/2001 was untimely.

A petition to the Commissioner under 37 CFR 1.137 may be filed requesting that the application be revived.

Under 37 CFR 1.137(a), a petition requesting the application be revived on the grounds of **UNAVOIDABLE DELAY** must be filed promptly after the applicant becomes aware of the abandonment and such petition must be accompanied by: (1) an adequate showing of the cause of unavoidable delay; (2) the required reply to the above-identified Notice; (3) the petition fee set forth in 37 CFR 1.17(l); and (4) a terminal disclaimer if required by 37 CFR 1.137(d).

Under 37 CFR 1.137(b), a petition requesting the application be revived on the grounds of **UNINTENTIONAL DELAY** must be filed promptly after applicant becomes aware of the abandonment and such petition must be accompanied by: (1) a statement that the entire delay was unintentional; (2) the required reply to the above-identified Notice; (3) the petition fee set forth in 37 CFR 1.17(m); and (4) a terminal disclaimer if required by 37 CFR 1.137(d).

Any questions concerning petitions to revive should be directed to the "Office of Petitions" at (703) 305-9282. Petitions should be mailed to: Mail Stop Petitions, Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450.

*A copy of this notice MUST be returned with the reply.*

Customer Service Center

Initial Patent Examination Division (703) 308-1202

PART 1 - ATTORNEY/APPLICANT COPY

MORGAN & FINNEGAN LLP  
 JUN 22 2004  
 4:11 PM



PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT  
ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)

Docket Number  
(Optional)  
4290-4000

First named inventor: Oystein IHLE

Application No.: 09/870,128

Group Art Unit: 1645

Filed: May 30, 2001

Examiner:

Title: METHOD FOR SEPARATING NUCLEIC ACIDS INTO POPULATIONS

Attention: Office of Petitions

**Mail Stop Petition**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

FAX: (703) 872-9306

Note: If information or assistance is needed in completing this form, please contact Petitions information at (703) 305-9282.

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the Office notice or action plus an extension(s) of time actually obtained.

**APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION**

Note: A grantable petition requires the following items:

- (1) Petition fee;
- (2) Reply and/or issue fee;
- (3) Terminal disclaimer with disclaimer fee -- required for all utility and plant applications filed before June 8 1995; and for all design applications; and
- (4) Statement that the entire delay was unintentional.

1. Petition fee

☒ Small entity-fee \$ 665.00 (37 CFR 1.17(m)). Applicant claims small entity status.  
See 37 CFR 1.27.

☐ Other than small entity -fee \$ \_\_\_\_ 37 CFR 1.17(m))

2. Reply and /or fee

A. The reply and/or fee to the above-noted Office action in the form of Reply to Notice of Missing Parts:

- ☐ has been filed previously on \_\_\_\_\_.  
☒ is enclosed herewith.

B. The issue fee of \$ \_\_\_\_.

- ☐ has been paid previously on \_\_\_\_\_.  
☐ is enclosed herewith.

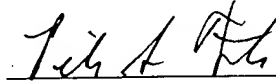
## 3. Terminal disclaimer with disclaimer fee

- ☒ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.
- ☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$\_\_\_\_\_ for a small entity or \$\_\_\_\_\_ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. STATEMENT: The entire delay in filing the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [NOTE: The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c)(III)(C) and (D))].

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

March 2, 2004  
Date

  
Signature

Telephone  
Number: (212) 303-2723

Peter G. Foiles  
Registration No. 46,477

MORGAN & FINNEGAN, L.L.P.  
345 Park Avenue  
New York, New York 10154

Enclosures: ☒ Fee Payment- the Commissioner is hereby authorized to charge any deficiencies or to credit any overpayments to Deposit Account No. 13-4500, order no. 4290-4000. A copy of this petition is enclosed.

- ☒ Reply  
☐ Terminal Disclaimer Form  
☒ Additional sheets containing statements establishing unintentional delay  
☒ Check in the amount of \$665.00.  
☒ Return Receipt Postcard

**CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]**

I hereby certify that this correspondence is being:

☐ deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to **Mail Stop Petition**, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

☐ transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (703) 308-6916.

\_\_\_\_\_  
Date

\_\_\_\_\_  
Reg. No.



GUARDIAN • SAFETY

Check number

YVKT1841

MORGAN & FINNEGAN, L.L.P.  
ATTORNEYS AT LAW  
345 PARK AVE.  
NEW YORK, NY 10154

033050

1-8210  
280

COMMISSIONER OF PATENTS AND TRADEMARKS

PAY  
TO THE  
ORDER OF

\$665.00

\$ 665.00  
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DATE 2/13/04

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150 EAST 53RD STREET  
NEW YORK, NY 10043

FOR 4290-4000 COTY

⑈033050⑈ ⑆021000089⑆ 400 37254775⑈

MP



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s): IHLE, Oystein et.al.

Group Art Unit: 1645

Serial No.: 09/870,128

Examiner:

Filed: May 30, 2001

For: Method for Separating Nucleic Acids into Populations

**Statement in Support of Petition to Revive Unintentionally Abandoned Patent Application**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

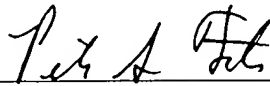
Sir:

The patent application 09/870,128, "Method for Separating Nucleic Acids into Populations" was filed as a US National Phase application on May 30, 2001 by the firm of Schwegman, Lundberg, Woessner & Kluth. The case was transferred from Schwegman to Morgan & Finnegan, L.L.P.. Morgan & Finnegan accepted the case on July 6, 2001.

On December 15, 2003 we received a "Notice of Acceptance of Power of Attorney" and noted that this Notice was received 16 months after filing of the Revocation and New Power of Attorney. We also noted that it had been 31 months since the case had been filed and we had not yet received a first Office Action. As part of our efforts to determine the status of the application, our Washington D.C. office copied the file on January 26, 2004. It was at this time that we first discovered that a "Notice to File Missing Parts" had been issued by the Patent Office on August 3, 2001 and sent to the firm of Schwegman, Lundberg, Woessner & Kluth. This Notice was never forwarded to Morgan & Finnegan and we did not become aware of this Notice until January 26, 2004. It was also noted that a Notice of Abandonment was not in the file nor, to date, has Morgan & Finnegan received a Notice of Abandonment. Therefore, the entire delay in filing the response to the Notice of Missing Parts was unintentional.

Respectfully submitted,  
MORGAN & FINNEGAN, L.L.P.

Dated: March 2, 2004

By: 

Peter G. Foiles

Registration No. 46,477

(212) 758-4800 Telephone

(212) 751-6849 Facsimile

Correspondence Address:

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